REMARKS

In a Final Office Action mailed on February 9, 2004, the Examiner maintained the § 103(a) rejections of claims 1-20. In particular, all of the § 103 rejections rely on the modification of Applicant's Admitted Prior Art (herein called "AAPA") in view of Lang. However, Applicant requests reconsideration of the § 103 rejections for the reasons stated below.

In the Final Office Action, the Examiner states, "the Examiner relies on Lang for the teaching of 'detecting whether some of the incoming bits indicate a synchronization field during the buffering of the incoming bits.'" Final Office Action, 4. However, Applicant submits that the combination of the AAPA and Lang fails to teach or suggest detecting whether incoming bits indicate a synchronization field during a buffering where this buffering accommodates a difference in rates between incoming and outgoing data. The § 103 rejection is based purely on hindsight, in that none of these references teaches synchronization detection during buffering that accommodates different rates of data.

In other words, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have combined Lang and the AAPA to derive the claimed invention. The Examiner has failed to make this showing, as there is no teaching or suggest in either reference, to detect a synchronization field during buffering of bits to accommodate different rates of data. As pointed out in the last reply, the AAPA teaches away from such an arrangement, in that the detection of the synchronization field occurs after the buffering of bits to accommodate to data. As Lang does not even mention buffering bits to accommodate different rates of incoming and outgoing data, there can be no teaching or suggestion in Lang to detect a synchronization field during such buffering.

The Examiner's position in this case is similar to the Examiner's position in *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). More specifically, in *In re Fine*, the Federal Circuit held that the Examiner had failed to establish a *prima facie* case of obviousness because of the Examiner's failure to offer any support for or explanation of this conclusion. *In re Fine*, 5 USPQ2d at 1599. The Federal Circuit agreed with the appellant that a *prima facie* case of obviousness had not been established and stated, "one cannot use hindsight reconstruction to pick and choose among

isolated disclosures in the prior art to deprecate the claimed invention." *Id.*, 1600. *See also, W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (stating, " to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, " rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment").

Therefore, for at least the reason that the combination fails to teach or suggest all claim limitations, a *prima facie* case of obviousness has not been established for any of the claims. Therefore, reconsideration of the final rejections and a favorable action in the form of a Notice of Allowance is requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0327US).

Respectfully submitted,

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